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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,888	11/13/2003	Prabodh P. Parekh	IFF-71	7765
48/861	7590	10/19/2009		
INTERNATIONAL FLAVORS & FRAGRANCES INC. 521 WEST 57TH ST NEW YORK, NY 10019				
EXAMINER				
GULLEDGE, BRIAN M				
ART UNIT		PAPER NUMBER		
1612				
MAIL DATE		DELIVERY MODE		
10/19/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/706,888

Applicant(s)

PAREKH ET AL.

Examiner

Brian Guldge

Art Unit

1612

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-16 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-16 and 18-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Previous Rejections

Applicants' arguments, filed July 22, 2009, have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 11-16, and 18-21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over O'Connor (US Patent 6,432,891) in view of Triplett et al. (US Patent Application Publication 2003/0199402). The Applicant argues that the rejection is not proper in view of the declaration filed on July 22, 2009 under 37 CFR 1.131. The Applicant argues that the declaration is sufficient to antedate the Triplett et al. reference.

The Examiner agrees with the Applicant in part. The Examiner agrees that the declaration provides sufficient support for the invention claimed by instant claims 2-8, and as such these claims are not rejected over O'Connor in view of Triplett et al. However, the Examiner does not feel that the declaration provides sufficient evidence to overcome the invention claimed by instant claims 1, 11-16, and 18-21. All of these claims utilize the composition recited by instant claim 1, which recites a monocyclic material selected from one of five options. The last option

recited is 2'-hydroxy-1'-ethyl(2-phenoxy)acetate. The declaration does not provide support for using this monocyclic material. Exhibits B and C provide evidence for the use of the other four options recited by instant claim 1, but not 2'-hydroxy-1'-ethyl(2-phenoxy)acetate. Thus, the scope of claims 1, 11-16, and 18-21 are not supported by the evidence filed. Claims 2-8 further limit the monocyclic material to the other four options instantly recited, and as such these claims are supported.

Claims 1-9, 11-16, and 19-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over O'Connor (US Patent 6,432,891) in view of Rohe et al. (US Patent 4,968,496). Applicant argues that the rejection is not proper, as the Applicant submits that the Examiner used impermissible hindsight reconstruction to establish the case for obviousness. The Applicant also argues that the art in malodor counteracting is unpredictable, and as such the rejection is improper.

The Examiner does not agree with these arguments. The Examiner does not believe that hindsight reconstruction was used in making the rejection. The rationale for the combination of the ingredients provided in the previous action was based on the statement that it is generally *prima facie* obvious to combine two compositions, each of which is taught by the prior art to be useful for same purpose (masking and counteracting malodors), in order to form a third composition to be used for the very same purpose. The idea for combining them flows logically from their having been individually taught in the prior art. See MPEP 2144.06. This is not viewed as impermissible hindsight reconstruction. The Examiner also does not agree that the art

in counteracting malodors is unpredictable. The Applicant provides no evidence to support this statement, and the prior art does not support this statement.

Claims 18 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Connor (US Patent 6,432,891) in view of Rohe et al. (US Patent 4,968,496) as applied to claim 1 above, and further in view of Pavlin et al. (US Patent 5,783,657). Applicant argues that the rejection is not proper, because the claims depend from claim 1, which was improperly rejected over O'Connor and Rohe et al. The Examiner does not agree with this argument, for the reasons discussed above with regards to the rejection of claim 1 over O'Connor and Rohe et al.

Conclusion

No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Gullede whose telephone number is (571) 270-5756. The examiner can normally be reached on Monday-Thursday 6:00am - 3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on (571) 272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BMG

/Frederick Krass/
Supervisory Patent Examiner, Art Unit 1612